

REMARKS

Claims 1, 3-12, 40-42 and 45-50 are presently pending; claims 13-39 and 44 are withdrawn; claims 2 and 43 are cancelled without prejudice.

Claim 1 was provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-17 of Application No. 10/763,534. This provisional rejection will be addressed should claim 1 be allowed.

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 4,925,683 to Fischbach et al. It is respectfully submitted that claim 1, as presently recited, is not anticipated by Fischbach. Fischbach does not disclose an inlet, and outlet and an air inlet. Instead, Fischbach discloses an envelope with neither an inlet nor an outlet, but rather the envelope is dissolvable.

Claims 1-12, 40-43 and 45 were rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 4,471,689 to Piana in view of Fischbach. It is respectfully submitted that claims 1, 3-12, 40-42 and 45 are not unpatentable over Piana in view of Fischbach.

With respect to claim 1, and claims 3-12 and 45 dependent therefrom, Piana does not disclose a cartridge having an inlet, an outlet and an air inlet. Instead, Piana discloses only an inlet conduit 44 and an outlet conduit 24. Fischbach also does not disclose an air inlet.

With respect to claim 40, and claims 41 and 42 dependent therefrom, Piana does not disclose an outer member and an inner member that are conjoined on assembly with the outer member. Instead, Piana discloses a two part cartridge with a cup part 12 having an opening covered by a lid part 14. The lid part 14 is not disposed entirely within the cup part 12, as illustrated in Fig. 2, and thus is not an "inner member." Fischbach also does not disclose the claimed outer member and inner member.

Moreover, and as discussed in the prior Amendment, Piana does not disclose a cartridge for use in a beverage preparation machine contain a beverage ingredient that is a liquid chocolate ingredient. To the contrary, Piana discloses a cartridge containing "powdery or granular matters, such as blends of powdered cocoa and powdered milk for the preparation of hot chocolate beverage." (Col. 2, ll. 47-50.) Piana also states that its

"invention relates to a disposable cartridge...which contains a dose of water-soluble granular, powdery or similar particulate matter..." (Col. 1, ll. 9-12.)

There is no motivation identified in the Office action in either Piana or Fischbach for their proposed combination. In fact, Piana teaches away from its use with a liquid product by stating that it is directed to a cartridge that purports to address deficiencies with prior cartridges for "freeze-dried or other water soluble products..." (Col. 1, l. 57 – col. 2, l. 4.) Fischbach teaches away from its use with a cartridge such as Piana because it is directed to a dissolvable envelope.

In view of the foregoing comments, it is respectfully submitted that claims 1, 3-12, 40-42 and 45 are allowable over Piana and Fischbach, and reconsideration and allowance are respectfully requested. New claims 46-50 are also believed to be allowable.

The Commissioner is hereby authorized to charge any additional fees which may be required in this application to Deposit Account No. 06-1135.

Respectfully submitted,

FITCH, EVEN, TABIN & FLANNERY

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/Jon A. Birmingham/

Jon A. Birmingham

Registration No. 51,222

120 S. LaSalle Street, Suite 1600
Chicago, Illinois 60603-3406
Telephone: 312.577.7000
Facsimile: 312.577.7007
489488